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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,344	12/06/2001	Yi Sik Chae	LT-0008	5265
34610	7590	09/19/2005	EXAMINER	
FLESHNER & KIM, LLP P.O. BOX 221200 CHANTILLY, VA 20153			VU, THONG H	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/003,344	<b>Applicant(s)</b> CHAE, YI SIK	
	<b>Examiner</b> Thong H. Vu	<b>Art Unit</b> 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*ET*

1. Claims 1 and 7 have been amended. Claims 8,9 are canceled. Claims 12-18 are added.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-7,10-18 have been considered but are moot in view of the new ground(s) of rejection. This is Final Rejection.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Amended claim 1 and new claim 12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "not permit" or "not occur", does not reasonably provide enablement for patentable. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. (i.e.: it clearly that in the time the transfer is not occur or permit, the first or second mobile terminal can do anything as desire).

4. Claims 1 and 12 contain the negative limitation.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion.

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Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi et al [takagi 5,881,231] in view of Steel et al [Steel, 6,564,047 B1]

5. As per claim 1, Takagi discloses a method of providing a file transfer service (i.e.: information transfer system) through a mobile communication network [Takagi, the radio or wired networks, a mobile terminal, col 7 lines 7-42], comprising the steps of:

(a) storing a data file and transfer conditioning information thereof received from a first mobile terminal connected through the mobile communication network [Takagi, transfer and storage means, col 3 lines 34 et seq.];

(b) transmitting information for transferring the data file through the mobile communication network based on the stored transfer conditioning information [Takagi, transfer of the necessary information, transfer time, col 4 line 16 et seq]; and

(c) checking response information sent from a second mobile terminal answering to said information for transferring the data file, and transferring the data file to the second mobile terminal based on the checked result [Takagi, controlling the transfer of information from the second apparatus to the first apparatus according to the determined transfer time and network to be used, col 4 line 32 et seq].

However Takagi does not explicitly detail  
wherein said transferring conditioning information includes a blocking time period set in the first mobile terminal of when not to permit a file transfer to occur by the first mobile terminal.

Steel discloses a wireless environment wherein the network devices stored the attributes in a management database for allowing, forbidding (restrict or not permit) and limit access of each network device [Steel, col 11 lines 14-47]

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the attributes or transfer condition of the mobile device for allowing, restricting or limiting access as taught by Steel into the Takagi's apparatus in order to utilize the time management. Doing so would provide the control to the time and cost management over the mobile network.

6. As per claim 2, Takagi-Steel disclose said transfer conditioning information includes transfer blocking time zone information [Takagi, time zone, col 11 line 5 et seq; date and time, col 12 line 57 et seq; transfer condition, col 16 lines 38-65], identification

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information of the first and the second mobile terminal, and size information of the data file to transfer [Takagi, size of information, col 17 lines 22 et seq].

7. As per claim 3, Takagi-Steel disclose said information for transferring the data file includes size information of the data file to transfer [Takagi, size, col 7 line 43 et seq].

8. As per claim 4, Takagi-Steel disclose said information for transferring the data file further includes type information of the data file to transfer [Takagi, check the type of data from the attribute, col 14 line et seq].

9. As per claim 5, Takagi-Steel disclose said response information includes spare storage capacity information of a peripheral device connected to the second mobile terminal [the storage capacity, col 7 line 43 et seq; transfer condition, col 16 lines 38-65].

10. As per claim 6, Takagi-Steel disclose said step (c) determines whether or not to transmit the data file based on the response information and the stored transfer conditioning information [Takagi, controlling the transfer of information from the second apparatus to the first apparatus according to the determined transfer time and network to be used, col 4 line 32 et seq].

11. As per claim 7, Takagi-Steel disclose A method of providing a file transfer service through a mobile communication network, comprising the steps of: (a) storing a data file [Takagi, transfer and storage means, col 3 lines 34 et seq.] and transfer conditioning information thereof received from a first mobile terminal connected through the mobile communication network [Takagi, transfer condition, col 16 lines 38-65]; (b) selecting one among the stored data files based on the stored transfer conditioning information; and (c) transferring the selected data file to a second mobile terminal specified as destination of the selected file [Takagi, selecting the procedure for transfer criteria, col 17 line 7; col 18 lines 21-50; col 22 line 56 et seq].

the transfer condition information includes information of a blocking time period of when to block a file transfer (i.e.: not permit) [Steel, the network devices stored the attributes in a management database for allowing, forbidding (or not permit) and limit access of each network device, col 11 lines 14-47]; and

select one data file whose transfer blocking time period is closet to current time [Takagi, the next discount time zone, col 22 lines 46-55].

12. As per claim 10 Takagi-Steel disclose said transfer blocking time zone is set to a time zone when voice traffic is normally congested as inherent feature of scheduled time.

13. As per claim 11 Takagi-Steel disclose said step (c) transmits another data file selected next based on the transfer conditioning information to a third mobile terminal

specified as destination of the next selected file, if trials of making connection to the second mobile terminal are failed as inherent feature of scheduled future time.

14. As per claim 12 Takagi-Steel disclose A file transfer method comprising:

requesting a blocking time period be set in a first mobile terminal at which a file transfer is **not** to occur selecting a file to transfer to a second mobile terminal [Steel, the network devices stored the attributes in a management database for allowing, forbidding (or not permit) and limit access of each network device, col 11 lines 14-47]; receiving by the second mobile terminal, a display message indicating the file selected by the first mobile terminal is ready for transfer at a time different than the time period at which the transfer is **not** to occur said display also including a size of the file to be transferred [Takagi, transfer condition, col 16 lines 38-65]; and delaying the file transfer until the second mobile terminal is connected to an external apparatus having a sufficient memory capacity to store the size of the file to be transferred [Takagi, selecting the procedure for transfer criteria, col 17 line 7; col 18 lines 21-50; col 22 line 56 et seq; judge that the information transfer at that point is necessary, col 23 lines 59-67; size of storage unit, col 30 lines 53-67].

15. As per claim 13 Takagi-Steel disclose the file selected in the first mobile terminal is stored on a file handling server with a plurality of other files to be transferred by other mobile terminals [Takagi, file server and a distributed file management function, col 2 lines 1-5].



16. As per claim 14 Takagi-Steel disclose the file handling server first transfers a file whose blocking time period is closest to a current time [Takagi, the next discount time zone, col 22 lines 46-55].

17. As per claim 15 Takagi-Steel disclose when the second mobile terminal is connected to the external apparatus, the second mobile terminal sends information about a memory capacity of the external apparatus to the file handling server and the file handle server determines whether the memory capacity of the file handling server is sufficient to store the file to be transferred [Takagi, size of storage unit, col 30 lines 53-67].

18. As per claim 16 Takagi-Steel disclose the file handling server transmits an error message to the second mobile terminal if the memory capacity is insufficient to store the file to be transferred [Takagi, error processing, col 20 lines 1-18].

19. As per claim 17 Takagi-Steel disclose wherein the file handling server transfers the file to the external apparatus via the second mobile terminal if the memory capacity is sufficient to store the file to be transferred and a current time is not within the blocking time period [Takagi, judge that the information transfer at that point is necessary, col 23 lines 59-67].

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20. As per claim 18 Takagi-Steel disclose the file handling server further transmits a message indicating a file transfer is in progress to the second mobile terminal when the file is being transferred to the external apparatus [Takagi, external device, col 7 lines 43-59].

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Thong Vu*  
*Patent Examiner*  
*Art Unit 2142*

